

### REMARKS

In the Office Action dated August 11, 2003, the drawings were objected to; claims 1-32 were rejected under 35 U.S.C. § 112, ¶ 1; claims 1-7, 9-18, 21-23, 29, and 30 were rejected under § 103 over Yoshimura (U.S. Patent No. 4,830,629) in view of Kuo (U.S. Patent No. 6,206,731) and Reuss (U.S. Patent No. 4,887,971); claims 8, 19, and 20 were rejected under § 103 over Yoshimura in view of Kuo, Reuss, Germany 124 (DE 9215124), and Young (U.S. Patent No. 4,401,355); claims 24 and 25 were rejected under § 103 over Van Doorn (U.S. Patent No. 6,482,017) in view of Germany 124; claims 24 and 26 were rejected under § 102, or in the alternative, under § 103, over Yoshimura; claims 25, 27, and 28 were rejected under § 103 over Yoshimura in view of Van Doorn and Germany 124; claims 7, 14, 31, and 32 were rejected under § 103 over Yoshimura in view of Kuo, Reuss, and Van Doorn; claims 1-7, 9, 10, 12-18, 21-23, and 29-32 were rejected under § 102 over Adelberger (U.S. Patent No. 4,160,572); claims 7, 11, and 13-16 were rejected under § 103 over Adelberger; claims 8 and 20 were rejected under § 103 over Adelberger in view of Germany 124; and claims 1, 3-6, 9, and 10 were rejected under § 102 over Kodama (U.S. Patent No. 5,338,211).

### OBJECTION TO THE DRAWINGS

Figures 2, 3, 4, 6, and 7 have been amended to address the objections. No new matter has been entered as a result of the drawing amendments.

### REJECTION UNDER 35 U.S.C. § 112, ¶ 1

With the amendment of the drawings, this rejection has been overcome.

### REJECTIONS UNDER 35 U.S.C. §§ 102 AND 103

Independent claim 1 recites a shield assembly having an electrically conductive cover defining a chamber to enclose a connector, an attachment mechanism adapted to attach the cover to a chassis, an electrically conductive gasket electrically contacted to the cover and adapted to be placed between the cover and the chassis, and a cable engagement body.

Claim 1 was rejected as being anticipated by Adelberger. Adelberger does not disclose an attachment mechanism to attach the cover to a chassis, or an electrically conductive gasket that is electrically contacted to the cover and adapted to be placed between the cover and the chassis.

Claim 1 was also rejected as being anticipated by Kodama. Kodama does not disclose an electrically conductive cover that defines a chamber to enclose a connector. The Office Action equated the cover recited in claim 1 with the cover 5 in Figure 1 of Kodama. The cover 5 disclosed in Kodama is made of a synthetic resin (Kodama, 3:2-3), which is an electrically non-conductive material.

Claim 1 was also rejected as being obvious over the asserted combination of Yoshimura, Kuo, and Reuss. It is respectfully submitted that the hypothetical combination of Yoshimura, Kuo, and Reuss does not disclose or suggest a shield assembly according to claim 1, since the hypothetical combination fails to disclose or suggest an electrically conductive gasket electrically contacted to the cover and adapted to be placed between the cover and chassis. Therefore, claim 1 is allowable over the asserted combination of Yoshimura, Kuo, and Reuss.

Independent claim 12 was rejected as being anticipated by Adelberger, or obvious over the combination of Yoshimura, Kuo, and Reuss. Adelberger fails to disclose a connector assembly having a connector with a housing formed of an electrically conductive material, and a cable extending from the connector and having a shield, where the housing is electrically connected to the shield of the cable.

Claim 12 is also allowable over the hypothetical combination of Yoshimura, Kuo, and Reuss, which fails to disclose or suggest the connector housing being electrically connected to the shield of a cable. The combination of Yoshimura, Kuo, and Reuss also fails to disclose or suggest a cable engagement body (of a shroud that encloses the connector housing) having an element to electrically contact a shield of the cable. In fact, the element in Yoshimura that was equated by the Office Action with the claimed connector is an insulating housing 20 (Figure 1 of Yoshimura), which is not formed of an electrically conductive material. Therefore, the element 20 of Yoshimura cannot be electrically connected to a shield of a cable. Moreover, Yoshimura fails to disclose or

suggest the shroud having a cable engagement body that has an element to electrically contact a shield of the cable. Neither Kuo nor Reuss discloses or suggests the elements missing from Yoshimura. Therefore, the combined teachings of the three references do not teach or suggest the invention of claim 12.

Independent claim 24 was rejected as being anticipated by Yoshimura, obvious over Yoshimura, or obvious over Van Doorn and Germany 124.

In the rejection of claim 24, the Office Action pointed to element 50 shown in Figure 1 of Yoshimura as being the shroud. Element 50 refers to an insulating molding (Yoshimura, 2:52), and thus cannot be considered an electrically conductive shroud, as recited in claim 24. Also, because the insulating molding 50 is an insulating material, Yoshimura teaches away from the use of an electrically conductive shroud. Therefore, claim 24 is not obvious over Yoshimura.

The Office Action has failed to establish a *prima facie* case of obviousness with respect to claim 24 over Van Doorn and Germany 124. Applicant notes that the rejection of claim 24 over the German reference (referred to as "Germany 124" in the Office Action) is inappropriate, since the Office Action has not provided a translation of the document. As stated by the MPEP, if a document is in a language other than English, and the Examiner seeks to rely on the document, "a translation must be obtained so that the record is clear as to the precise facts the Examiner is relying upon in support of the rejection." MPEP § 706.02 (8<sup>th</sup> ed., Rev. 1), at 700-20 (Feb. 2003). Because a translation of the Germany 124 reference has not been provided by the Office Action, the obviousness rejection of claim 24 over the combination of Van Doorn and Germany 124 is improper and should be withdrawn.

Also, the Office Action has failed to establish that there existed a motivation or suggestion to combine the teachings of Van Doorn and Germany 124. Except for a conclusory statement in the Office Action that it is "[o]bvious to use such a connector in Van Doorn at 16," no rationale was provided by the Office Action regarding why there existed a motivation or suggestion to combine the teachings of Van Doorn and Germany 124. The Office Action cited to no passages within the teachings of Van Doorn or Germany 124 to support the allegation that a person of ordinary skill in the art would

have been motivated to combine the teachings of Van Doorn and Germany 124. As stated by the MPEP, "[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP § 2143 at 2100-124. The Office Action has failed to establish this requirement of the *prima facie* case of obviousness.

Another requirement of the *prima facie* case of obviousness is that there must be a reasonable expectation of success. The Office Action has failed to establish that such reasonable expectation of success existed.

In view of the foregoing, it is respectfully submitted that the claim 24 is allowable over the cited references.

Independent claim 29 was rejected as being anticipated by Adelberger, and also as being obvious over the combination of Yoshimura, Kuo, and Reuss. Adelberger does not disclose a connector having a housing electrically connected to a shield of a cable. The hypothetical combination of Yoshimura, Kuo, and Reuss also does not teach or suggest a connector having a housing electrically connected to a cable shield. Nor does the hypothetical combination of Yoshimura, Kuo, and Reuss teach or suggest an electrically conductive shroud enclosing the connector that electrically connects to the cable shield.

Claim 8 has been amended from dependent form to independent form. Claim 8 was rejected as being obvious over Yoshimura, Kuo, Reuss, Germany 124, and Young, or obvious over Adelberger and Germany 124.

The obviousness rejections are defective because the Examiner has not provided an English translation of Germany 124. Moreover, the Office Action has provided no rationale to support the allegation that the references can be combined in the manner proposed by the Office Action. No support was given by the Office Action regarding what motivation or suggestion existed to combine the references. Also, no rationale was given by the Office Action regarding likelihood of success of the proposed combination of reference teachings. In fact, in the rejection of the claim over Yoshimura, Kuo, Reuss, Germany 124, and Young, the Office Action did not even make any comment regarding

how Young has any relevance with respect to claim 8. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 8 over Yoshimura, Kuo, Reuss, Germany 124, and Young.

Similarly, with respect to the obviousness rejection of claim 8 over Adelberger and Germany 124, no rationale has been provided regarding the motivation or suggestion to combine. A *prima facie* case of obviousness has also not been established with respect to claim 8 over Adelberger and Germany 124.

Claim 14 has also been amended from dependent form to independent form. Claim 14 was rejected as being anticipated by Adelberger, obvious over Adelberger, obvious over Yoshimura, Kuo, and Reuss, or obvious over Yoshimura, Kuo, Reuss, and Van Doorn.

Adelberger fails to disclose or suggest a connector assembly having a connector with a housing formed of an electrically conductive material, and a cable extending from the connector and having a shield, where the connector housing is electrically connected to the shield of the cable. Therefore, claim 14 is not anticipated or rendered obvious by Adelberger.

They hypothetical combinations of Yoshimura, Kuo, and Reuss and of Yoshimura, Kuo, Reuss, and Van Doorn also fail to disclose or suggest a connector housing being electrically connected to the shield of a cable.

All dependent claims are allowable for at least the same reasons as corresponding independent claims.

In view of the foregoing, all claims are in condition for allowance, which action is respectfully requested. The Commissioner is authorized to charge any additional fees, including extension of time fees, or credit any overpayment to Deposit Account No. 50-1673 (9793).

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Respectfully submitted,

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Dan C. Hu, Reg. No. 40,025  
Trop, Pruner & Hu, P.C.  
8554 Katy Freeway, Ste. 100  
Houston, TX 77024  
713/468-8880  
713/468-8883 [fax]